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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/618,716	07/18/2000	Kyoji Saito	P19789	9554

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EXAMINER	
PHAN, TAM T	

ART UNIT	PAPER NUMBER
2144	

DATE MAILED: 06/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/618,716	SAITO, KYOJI	
	Examiner	Art Unit	
	Tam (Jenny) Phan	2144	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04/14/2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *13-36* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *13-36* is/are rejected.

7)☐ Claim(s) *30,31,35 and 36* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *18 July 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Amendment received on 04/14/2005 has been entered. Claims 13-36 are presently amended. Claims 1-12 are cancelled.

2. Claims 13-36 are presented for examination.

Priority

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-d, which papers have been placed of record in the file.

4. The effective filing date for the subject matter defined in the pending claims which has support in parent JP 11-321411 in this application is 11/11/1999. Any new subject mater defined in the claims not previously disclosed in parent JP 11-321411, is entitled to the effective filing date of 07/18/2000.

5. Should applicant desire to obtain the benefit of foreign priority under 35 U.S.C. 119(a)-(d) prior to declaration of an interference, a translation of the foreign application should be submitted under 37 CFR 1.55 in reply to this action.

Claim Objections

6. Claims 30-31 and 35-36 objected to because of the following informalities: "character sting" should read "character string". Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 27-29 recites the limitation "the image receiving apparatus comprising" in claim 27 lines 4-5. There is insufficient antecedent basis for this limitation in the claim.

"the image receiving apparatus comprising" should read "the image communication apparatus comprising".

9. Claims 30-31 recites the limitation "the image receiving apparatus comprising" in claim 30 lines 4-5. There is insufficient antecedent basis for this limitation in the claim. "the image receiving apparatus comprising" should read "the image communication apparatus comprising".

10. Claims 32-34 recites the limitation "the image receiving method comprising" in claim 32 lines 6-7. There is insufficient antecedent basis for this limitation in the claim. "the image receiving method" should read "the image communication method comprising".

11. Claims 35-36 recites the limitation "the image receiving method comprising" in claim 32 lines 6-7. There is insufficient antecedent basis for this limitation in the claim. "the image receiving method" should read "the image communication method comprising".

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

13. Claims 13-15 and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toyoda et al. (U.S. Patent Number 5,812,278), hereinafter referred to

as Toyoda in view of RFC2305 (RFC2305 – "A Simple Mode of Facsimile Using Internet MAIL" March 1998).

14. Regarding claim 13, Toyoda disclosed an image receiving apparatus comprising: a receiver configured to receive an e-mail with data attached, via a computer network (column 3 lines 20-23); and a controller configured to convert the attached data into image data; the controller further being configured to judge whether or not the received e-mail is an error mail, the error mail being related to an e-mail transmitted by the image receiving apparatus based on whether or not a header of the received e-mail includes a predetermined character string (column 6 lines 38-46, lines 57-61, column 7 lines 52-63).

15. Toyoda taught the invention substantially as claimed. However, Toyoda did not expressly teach the predetermined character string being related to a sender of the error mail.

16. Toyoda suggested exploration of art and/or provided a reason to modify the image apparatus with the predetermined character string being related to a sender of the error mail (column 6 lines 57-61, column 7 lines 52-63).

17. RFC 2305 disclosed teachings of judging the received e-mail based on whether or not a header of the e-mail includes a predetermined character string, the predetermined character string being related to a sender of the error mail (Sections 2.2.1, 5.1, 5.2.1, 5.2.2).

18. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the image receiving apparatus of Toyoda with the

teachings of RFC2305 to include the sender judging feature in order to maintain interoperability with Internet mail (Section 5.1) since any security to be provided should be part of the Internet security infrastructure (Section 5.1). In addition, parsing the sender to determine the mail status would also help save resources since unnecessary processing or error or failure mails consume resources and therefore undesirable (Section 5.2.2 paragraphs 1-2).

19. Regarding claim 14, the Toyoda disclosed an image receiving apparatus further comprising a printer configured to print the image data, wherein the controller, when an error mail is detected, abstracts predetermined information from the e-mail, and converts the abstracted predetermined information into image data, and the printer prints the converted image data (column 1 lines 43-61, column 19 lines 24-50, column 20 lines 3-52).

20. Regarding claim 15, the Toyoda disclosed an image receiving apparatus further comprising a printer configured to print image data, wherein the controller, when an error mail is detected, abstracts predetermined information from the e-mail, edits the abstracted predetermined information, and converts the edited information into image data, and the printer prints the converted image data (column 1 lines 43-61, column 19 lines 24-50, lines 57-61, column 20 lines 3-52).

21. Regarding claim 20-22, the method corresponds directly to the image receiving apparatus of claims 13-15, and thus these claims are rejected using the same rationale.

22. Since all the limitations of the claimed invention were disclosed by the combination of Toyoda and RFC2305, claims 13-15 and 20-22 are rejected.

23. Claims 16-19, 23-26, 27, and 32, are rejected under 35 U.S.C. 103(a) as being unpatentable over Toyoda et al. (U.S. Patent Number 5,812,278), hereinafter referred to as Toyoda in view of Praitis et al. (U.S. Patent Number 6,594,697), hereinafter referred to as Praitis, and further in view of Mori (U.S. Patent Number 6,417,930).

24. Regarding claim 16, Toyoda disclosed an image receiving apparatus receiving an e-mail, the e-mail including a header and a body, the body including a message, the message including an image data part (Figures 6-7), the image receiving apparatus comprising: a receiver configured to receive an e-mail with data attached, via a computer network (column 3 lines 20-23); and a controller configured to convert the attached data to image data (column 1 lines 42-61); and the controller further being configured to search for a predetermined information, and to judge that the received e-mail is an error mail the error mail being related to an e-mail transmitted by the image receiving apparatus, the error mail being related to an e-mail transmitted by the image receiving apparatus, when the predetermined information is detected (column 6 lines 38-46, lines 57-61, column 7 lines 52-63).

25. Toyoda taught the invention substantially as claimed. However, Toyoda did not expressly teach searching for a predetermined image data fixed code in the image data part of the e-mail [body of the email] and to judge that the received e-mail is an error mail when the predetermined image data fixed code is detected.

26. Toyoda suggested exploration of art and/or provided a reason to modify the image receiving apparatus with the searching of signature code in a multi-part mail structure (Figure 7, column 13 lines 20-25, column 29 lines 5-11).

27. Praitis disclosed a controller for searching a predetermined data code in the data part of the electronic message and to judge that the received message is an error message, the electronic message being related to a message request transmitted by the receiving apparatus, when the predetermined data code is detected (Abstract, Figures 2-3, 5-6, Figure 7,column 9 lines 10-22, lines 34-51).

28. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the apparatus of Toyoda with the teachings of Praitis to include the searching of data code in an electronic message structure in order to provide a more efficient method of identify the related error since the server often create a returned message response having error information in the header and in the body of the message (Praitis, column 9 lines 18-22).

29. The combination of Toyoda and Praitis taught the invention substantially as claimed, however, the combination of Toyoda and Praitis did not expressly teach a multi/part structure electronic message having a predetermined data fixed code.

30. Mori disclosed a network facsimile apparatus having a receiver configured to receive e-mails and a controller for searching a predetermined image data fixed code [boundary code] in the image data part of the e-mail when the received e-mail is a multi-part structure (Figures 5, 7, 10AA, column 11 lines 25-34, column 13 lines 40-57).

31. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the combined apparatus of Toyoda and Praitis with the teachings of Mori to include the searching of image data fixed code in a multi-part mail structure in order to provide a more accurate method of identify error mail since header information are trivial to fake or unavailable and image data fixed code is often present in multi-part mail structure (Mori, Figures 5, 7).

32. Regarding claim 17, Mori disclosed an image receiving apparatus wherein the controller searches for the predetermined image data fixed code in the whole received e-mail when the received e-mail is a single-part structure, and judges that the received e-mail is an error mail when the predetermined image data fixed code is detected (Figure 7, column 11 lines 25-34, column 13 lines 40-57).

33. Regarding claim 18, Toyoda disclosed an image receiving apparatus further comprising a printer configured to print image data, wherein the controller, when an error mail is detected, abstracts predetermined information from the e-mail, and converts the abstracted predetermined information into image data, and the printer prints the converted image data (column 1 lines 43-61, column 19 lines 24-50, column 20 lines 3-52).

34. Regarding claim 19, Toyoda disclosed image receiving apparatus further comprising a printer configured to print image data, wherein the controller, when an error mail is detected, abstracts predetermined information from the e-mail, edits the abstracted predetermined information, and converts the edited information into image

data, and the printer prints the converted predetermined image data (column 1 lines 43-61, column 19 lines 24-50, lines 57-61, column 20 lines 3-52).

35. Regarding claim 23-26, the method corresponds directly to the image receiving apparatus of claims 16-19, and thus these claims are rejected using the same rationale.

36. Regarding claim 27, Toyoda, Praitis, and Mori combined disclose an image receiving apparatus connected to a server and receiving an e-mail, when the received e-mail is an error mail, the e-mail including a header and a body, the body including a message, the message including an image data part (Toyoda, Figures 6-7, column 13 lines 20-25), the image receiving apparatus comprising: a receiver configured to receive an e-mail to which data is attached, via the server; a converter configured to convert the attached data into image data (Toyoda, column 1 lines 42-61); a memory configured to store a predetermined image data fixed code, an image data fixed code being contained in the image data part (Toyoda, column 1 lines 42-61, column 7 lines 52-63; Praitis, Abstract, Figures 2-3, 5-6, Figure 7,column 9 lines 10-22, lines 34-51; Mori, Figures 5, 7, 10AA, column 11 lines 25-34, column 13 lines 40-57); and a controller configured to search for a predetermined header fixed message in the header of the received e-mail, to search for an image data fixed code in the image data part of the message of the body of the received e-mail when the predetermined header fixed message is not in the header of the received e-mail, and to judge that the received email is an error mail, the error mail being related to an e-mail transmitted by the image receiving apparatus, when the image data fixed code in the received e-mail matches the predetermined image data fixed code stored in the memory (Toyoda column 6 lines 38-46, lines 57-61, column 7

lines 52-63; Praitis, Abstract, Figures 2-3, 5-6, Figure 7,column 9 lines 10-22, lines 34-51; Mori, Figures 5, 7, 10AA, column 11 lines 25-34, column 13 lines 40-57).

37. Regarding claim 32, the method corresponds directly to the image receiving apparatus of claims 27, and thus is rejected using the same rationale.

38. Since all the limitations of the claimed invention were disclosed by the combination of Toyoda, Praitis, and Mori, claims 16-19, 23-26, 27, and 32 are rejected.

39. Claims 28-29 and 33-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toyoda et al. (U.S. Patent Number 5,812,278), hereinafter referred to as Toyoda, in view of Praitis et al. (U.S. Patent Number 6,594,697), hereinafter referred to as Praitis, in view of Mori (U.S. Patent Number 6,417,930), and further in view of Iwazaki (U.S. Patent Number 6,687,742).

40. The combination of Toyoda, Praitis, and Mori disclosed an image communication apparatus with all the limitations listed in claim 27 rejection above.

41. The combination of Toyoda Praitis, and Mori taught the invention substantially as claimed. However, Toyoda, Praitis, and Mori combined did not expressly teach the predetermined header fixed message comprises [X:mailer:] field.

42. Mori suggested exploration of art and/or provided a reason to modify the image receiving apparatus with other header fields (Figure 7, column 7 lines 50-62, column 11 lines 25-34, column 19 lines 30-35).

43. Iwazaki disclosed a predetermined header fixed message comprises [X:mailer:] field (Figure 5, column 6 lines 28-38, column 7 lines 27-50).

44. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the combined apparatus of Toyoda, Praitis, and Mori to include the [X:mailer:] field in header parsing feature since it would be preferable to includes all identification data needed to determine the status of incoming mail. Most users preferred to implement header parsing based upon additional list categories, such as the "TO", "FROM", "MESSAGE-ID", "CONTENT-TYPE" email headers as well as other headers (Mori, column 7 lines 57-62, column 13 lines 40-57).

45. Regarding claim 29, Iwazaki image receiving apparatus wherein the predetermined image data fixed code comprises SUqk (Figure 9).

46. Regarding claim 33-34, the method corresponds directly to the image receiving apparatus of claims 28-29, and thus is rejected using the same rationale.

47. Since all the limitations of the claimed invention were disclosed by the combination of Toyoda, Praitis, Mori, and Iwazaki, claims 28-29, and 33-34 are rejected.

Response to Arguments

48. Applicants' arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection. Referred to above rejections for details.

49. In response to applicant's argument based upon the age of the references specifically reference Iwazaki (U.S. Patent Application 6,687,742 filed 05/31/2000), contentions that the reference patents are old are not impressive absent a showing that the art tried and failed to solve the same problem notwithstanding its presumed knowledge of the references. See *In re Wright*, 569 F.2d 1124, 193 USPQ 332 (CCPA

1977). Should applicant desire to obtain the benefit of foreign priority under 35 U.S.C. 119(a)-(d) prior to declaration of an interference, a translation of the foreign application should be submitted under 37 CFR 1.55 in reply to this action.

50. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

51. In response to applicant's argument that Toyoda et al. judges the error mail, by a comparison of passwords, or by comparison of a mail address of a receiver with the receiver's e-mail address, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

52. As the rejection reads, Examiner asserts that the combination of these teachings render the claimed invention obvious.

Allowable Subject Matter

53. Claims 30-31 and 35-36 would be allowed if applicants overcome the Claim Objections and the ***35 USC § 112*** Rejection as detailed above.

54. The claimed invention involves an image communication apparatus connected to a server and receiving an e-mail, the received e-mail including a header and a body, the body including a message, the message including an image data part, the image

communication apparatus comprising: a receiver configured to receive an e-mail with data attached, via the server; a converter configured to convert the attached data into image data; a first memory configured to store at least one predetermined character string; a second memory configured to store a predetermined image data fixed code, an image data fixed code being contained in the image data part; and a controller configured to search for character string in a [From:] field of the header of the received e-mail, to compare the character string in the [From:] field of the header with the at least one predetermined character string stored in the first memory, to search for an image data fixed code in the image data part of the message of the body of the received e-mail when the character string in the (From:) field of a header matches the at least one predetermined character string stored in the first memory, and to judge that the received e-mail is an error mail. the error mail being related to an e-mail transmitted by the image receiving apparatus when the image data fixed code in the received e-mail matches the predetermined image data fixed code stored in the second memory.

55. The following is an examiner's statement of reasons for allowance: the limitations of searching for an image data fixed code in the image data part of the message of the body of the received e-mail when the character string in the (From:) field of a header matches the at least one predetermined character string stored in the first memory, and judging that the received e-mail is an error mail, the error mail being related to an e-mail transmitted by the image receiving apparatus when the image data fixed code in the received e-mail matches the predetermined image data fixed code stored in the second memory (defined in the present specification per Page 13 lines 2-17, page 16 lines 2-

12, page 17 line 21-page 18 line 6, page 21 lines 18-page 22 line 4, page 24 line 26-page 25 line 27), and conformed to present drawing per Figures 6-8) was not taught or suggested by the prior art of record *in combination with the other limitations of the independent claims*. This functionality is explained further in the arguments of Amendment received on 04/14/2005 per Pages 15-16. Note: According to the specification, image data fixed code is a character string that is always added to the TIFF file transmitted by the communication apparatus and the image data fixed code is recorded in the second memory of the communication apparatus for comparison.

Conclusion

56. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Refer to the enclosed PTO-892 for details.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tam (Jenny) Phan whose telephone number is (571) 272-3930. The examiner can normally be reached on M-F 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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